



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/721,557	11/22/2000	Mark Moriconi	PA1630US	5061

7590 08/02/2004  
SHELDON R. MEYERS, ESQ.  
FLIESLER DUBB MEYER & LOVEJOY LLP  
FOUR EMBARCADERO CENTER  
FOURTH FLOOR  
SAN FRANCISCO, CA 94111-4156

EXAMINER

NORRIS, TREMAYNE M

ART UNIT PAPER NUMBER

2137

DATE MAILED: 08/02/2004

11

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/721,557

Applicant(s)

MORICONI ET AL.

Examiner

Tremayne M. Norris

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 16,29 and 57-89 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16,29 and 57-89 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3.5.7</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 16 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,158,010. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 16 is just a broader version of claim 9 of US pat 6,158,010.

3. Claim 29 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 27 of U.S. Patent No. 6,158,010. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 29 is just a broader version of claim 27 of US pat 6,158,010.

4. Claims 57-62 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,158,010. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 57-62 are just broader versions of claim 1 of US pat 6,158,010.

5. Claims 63-68 and 72-77 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 45 of U.S. Patent No. 6,158,010. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 63-68 and 72-77 are just broader versions of claim 45 of US pat 6,158,010.

6. Claims 81-86 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 49 of U.S. Patent No. 6,158,010. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 81-86 are just broader versions of claim 49 of US pat 6,158,010.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 72-80 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims that claim both an apparatus and the method steps of using the apparatus are indefinite under 35 U.S.C. 112 second paragraph.

***Claim Rejections - 35 USC § 101***

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 72-80 rejected under 35 U.S.C. 101 because these claims are directed to neither a process nor a machine, but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 69-71, 78-80, 87-89 are rejected under 35 U.S.C. 102(e) as being anticipated by Nessett et al (US pat 5,968,176)

Regarding claim 69, Nessett teaches a method for maintaining security in a distributed computing environment, comprising:

managing a security policy via a policy manager (col.6 lines 64-66); and  
managing, via an application guard, access to securable components as specified by the security policy (col.7 lines 7-12; col.7 lines 41-45);

wherein the application guard further allows for additional customized code to process and evaluate authorization requests based on the additional customized code (col.7 lines 22-45).

Regarding claim 70, Nessett teaches a method for controlling user access via a system in a distributed computing environment, comprising:

specifying via a global policy privileges of the user to access securable components (col.3 lines 29-34);

managing and distributing, via a policy manager, to a client, a local client policy based on the global policy (col.6 lines 64-66), and

managing, via an application guard located on the client, access to the securable components as specified by the local client policy (col.7 lines 7-12; col.7 lines 41-45);

wherein the application guard further allows for additional customized code to process and evaluate authorization requests based on the additional customized code (col.7 lines 22-45).

Regarding claim 71, Nessett teaches a method for authorization that provides for a user access to securable components of a system, comprising:

specifying via a policy privileges of the user to access the securable components (col.8 lines 27-33);

managing via an application guard access to the securable components (col.7 lines 7-12; col.7 lines 41-45); and

executing the application guard via a processor coupled to the system (col.7 lines 31-35);

wherein the application guard further allows for additional customized code to process and evaluate authorization requests based on the additional customized code (col.7 lines 22-45).

Claims 78-80 are substantially equivalent to claims 69-71 respectively, therefore claims 78-80 are rejected because of similar rationale.

Claims 87-89 are substantially equivalent to claims 69-71 respectively, therefore claims 87-89 are rejected because of similar rationale.

**Conclusion**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tremayne M. Norris whose telephone number is (703) 305-8045. The examiner can normally be reached on M-F 7:30AM-5:00PM alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (703) 306-3036. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Tremayne Norris

July 15, 2004

  
**MATTHEW SMITHERS**  
**PRIMARY EXAMINER**  
*Art Unit 2137*